

REMARKS

Claims 1-27 are pending in the application. Claim 1 is an independent claim. Claims 6 and 10 directed toward a non-elected species are withdrawn. Claims 4, 17-25, and 27 have been amended. Examination and consideration of the application, as amended, are hereby respectfully requested.

Election

Examiner has pointed out two patentably distinct species of the invention: Species I including a coplanar surface as in Fig. 8, and Species II including a non-coplanar surface as in Fig. 9. Examiner has deemed Claim 1 to be generic.

Applicants hereby elect Species I, without traverse, and acknowledge Examiner's determination that Claim 1 is generic to both species.

Applicants respectfully submit that Species I encompasses Claims 7, 8, 11, and 12, each of which recites substantially coplanar waveguide and structural upper cladding surfaces. Applicants respectfully submit that Species II encompasses Claims 6 and 10, each of which recites non-coplanar waveguide and structural upper cladding surfaces. Applicants respectfully submit that Examiner's notation that the species with coplanar surfaces is directed to Claims 6 and 10 is in error.

Claims 2-4 and 13-27 do not recite any upper cladding surface other than the waveguide upper cladding surface. Claims 5 and 9 each recite separate waveguide and structural upper cladding surfaces, but are each silent as to whether those surfaces are planar or non-coplanar. Applicants therefore respectfully submit that Claims 2-5, 9, and 13-27 are generic to Species I and II, and respectfully request that they be examined along with the elected claims of Species I and generic Claim 1.

Amendment

In a case recently decided by the United States Court of Appeals for the Federal Circuit (CAFC), certain claim language in one of the patents at issue, similar to language originally employed in some of the claims of the instant application, has been construed in a manner differing from that intended by the Applicants. It is not clear whether the CAFC claim construction is specific to the fact patterns of the decided case, or may be applied more generally. Accordingly, the claims in question have been amended so as to ensure that the claims will be construed in the manner originally intended by the Applicants.

The recently-decided case is *Superguide Corporation v. Directv, Inc.* (CAFC 02-1561, -1562, and -1594, decided 02/12/2004). At least within the context of *Superguide*, the Court has interpreted “at least one of” followed by a conjunctive list of items in the patent in suit (US 5038211) to mean at least one of *each* item in the list. In the instant application, the Applicants intended “at least one of” followed by such a list to mean at least one item *from* the list. Since the claim construction of the CAFC in *Superguide* may at least raise the possibility of a narrower claim construction than that intended by the Applicants, Claims 4, 17-25, and 27 have been amended. In each instance, the phrase “at least one of” has been deleted, and the conjunction “and” in the subsequent pair or list of items has been replaced by the conjunction “or”. In the amended claims, the conjunction “or” is to be construed inclusively (e.g., “a dog or a cat” would be interpreted as “a dog, or a cat, or both”; “a dog, a cat, or a mouse” would be interpreted as “a dog, or a cat, or a mouse, or any two, or all three”; Bryan A. Garner, Elements of Legal Style p. 103, 2nd ed. 2002), unless: i) it is explicitly stated otherwise, e.g., by use of “either...or”, “only one of”, or similar language; or ii) two or more of the listed alternatives are mutually exclusive within the context of the claim, in which case “or” would encompass only those combinations involving non-mutually-exclusive alternatives. Applicants believe that this amendment does not change the scope of the amended claims from the originally intended scope. In particular, the amendments set forth herein are not narrowing amendments.

Conclusion

In view of the above, it is submitted that Claims 1-5, 7-9, and 11-27 are ready for examination. Allowance of Claims 1-5, 7-9, and 11-27, and reinstatement and allowance of Claims 6 and 10, is earnestly solicited.

Respectfully submitted,

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